

REMARKS/ARGUMENTS

In response to the Office Action dated November 20, 2003, claims 1, 6, 10, 11 and 14 are amended. Claims 1-18 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In support of this position, the Examiner contends that “by same language group” is vague and indefinite.

The rejection of claims 6-18 is respectfully traversed. The language “by same language group” appears in independent claim 1 only. Claims 2-5 depend directly or indirectly from claim 1. However, claims 6-18 do not depend directly or indirectly from claim 1. Since the language “by same language group” does not appear in claims 6-18, the claims are definite and withdrawal of the rejection of these claims as being indefinite is respectfully solicited.

To expedite prosecution, claim 1 is amended to recite, *inter alia*:

wherein, in a case where the first mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, each different from an original language of the document data, and controls said output unit so as to output the translated document data by language groups, each group including the translated document data translated in a common language that is different from each other group, and

wherein, in a case where the second mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, each different from the original language of the document data, and controls said output unit so as to output the translated document data by ~~group~~ groups, each group including the translated language document data translated in each of the plurality of languages.

Amended claim 1 is believed to recite the invention with the degree of precision and particularity required by the statute. Therefore, it is respectfully urged that the rejection of claims 1-5, as being indefinite, be withdrawn.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 108 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi et al. (USPN 5,701,497).

Referring to amended claim 1, the Examiner maintains that Yamauchi et al. discloses a mode setting unit for setting the translating apparatus in a first mode or a second mode, at column 4, lines 36-60, via the mode selector for activating either the first output or the second output means. However, claim 1 also requires “wherein, in a case where the first mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, each different from an original language of the document data, and controls said output unit so as to output the translated document data by language groups, each group including the translated document data translated in a common language that is different from each other group, and wherein, in a case where the second mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, each different from the original language of the document data, and controls said output unit so as to output the translated document data by group groups, each group including the translated language document data translated in each of the plurality of languages.”

The Examiner admits that Yamauchi et al. does not teach translating the received document (data) into a plurality of language. Given such admission, it is readily apparent that Yamauchi et al. does not disclose setting a first mode so that the controller controls the

translating means to translate the document data into *a plurality of languages, each different from an original language of the document data*, and controls the output unit so as to output the translated document data by group, each group including the translated document data translated in a common language, and setting a second mode so that the controller controls the translating means to translate the document data *into a plurality of languages, each different from the original language of the document data*, and controls the output unit so as to output the translated document data by group, each group including the translated language document data translated in each of the plurality of languages.

More specifically, since the mode setting unit is tied to setting modes that require the controller to control the translating means to translate document data into a plurality of languages, each different from the original language of the document, and since Yamauchi et al. does not disclose or suggest to translate document data into a plurality of languages, each different from the original language of the document, Yamauchi et al. does not disclose the required mode setting unit.

In addition, while the Examiner contends that Flores et al. teaches an apparatus for translating an original text into a plurality of languages in Figure 4, column 5, lines 27-57, this is incorrect as Figure 4 illustrates the method involved in creating the database, which is to start with original text, translate them into different languages and store the translated text in a database.

As noted in the previous Response, Flores discloses that an original contained in a work is translated into a plurality of languages and the translated languages are registered as a data base 16. Flores discloses further that a certain language text selected by a user is read out from the data base 16 and then displayed on a display panel (see Fig. 5A). Thus, Flores merely

discloses creating a database of both an original document (as a text of language 1) and of translations of the original document (second, third, etc. language as the methodology of FIG. 4 illustrates). As described at column 6, lines 48-57:

A user will generally choose to view a work in the written text of two or more languages presented adjacently (See FIG. 5A). *Once the user has selected the work the user wishes to view and has chosen the languages the user wishes to view the work in, the accessing program or device will retrieve the chosen texts and display them on the user's monitor.* This type of adjacent text presentation may be particularly helpful to users or students familiar with one language and attempting to learn or strengthen their reading and/or writing skills or understanding in a second language. (emphasis added)

There is clearly no translating means that translate document data into each of the selected languages. In this regard, Flores is quite adamant that when the text of the original work is translated into a second language, automatic machine translation will not surface as the second language translation is not a literal translation, which is produce by such machine translations. There is no disclosure or suggestion as to how such second language translation is created. The only disclosure in Flores is that such translation is created.

Thus, the only reasonable teaching in Flores is that there is a database having a plurality of non-literal translations of original document data and that such translations can be retrieved for display. However, there is no teaching as to how such translations are created.

Since Yamasuchi et al. is concerned with a telecommunication apparatus, such as a facsimile, that includes a translation unit *for translating a received document from a source language into a target language*, there is no realistic motive to modify Yamasuchi et al. to create a data base of a plurality of non-literal, different language translations of each received document, and then having a user retrieve selected translations. While the Examiner states that

such translation into a plurality of languages “would be beneficial to monolingual and multi-lingual users”, Yamasuchi et al. does not disclose such benefit.

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Recognizing, after the fact, that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 F.2d 1011, 154, USPQ 173 (CCPA 1967).

It is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from references to fill in the gaps. *In re Gorman*, 18 USPQ2d 1885 (Fed. Cir. 1991).

Clearly, no portion of Yamauchi of is referred to by the Examiner as suggesting the desirability of translating a received document into a plurality of languages, let alone that such translation “would be beneficial to monolingual and multi-lingual users”. In accordance with the case law precedent noted above, without Yamauchi et al. disclosing or suggesting the desirability of the modification suggested by the Examiner, the only reasonable conclusion is that the modification is suggested only because Applicants disclose and claim this feature. However, Applicants' disclosure may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

It is, therefore, respectfully submitted that present rejections are an example of improper reconstruction of the claimed invention using Applicants' disclosure as a guide. Consequently, the Examiner has not established the requisite motivation for the proposed combination of references to arrive at the claimed invention. Accordingly, withdrawal of the Examiner's rejection of claims 1-18 under 35 U.S.C. § 103 is respectfully solicited.

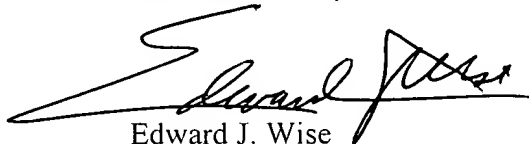
CONCLUSION

Accordingly, it is urged that the application, as amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'Edward J. Wise', is written over a horizontal line.

Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 EJW/dmd
Facsimile: (202) 756-8087
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